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Appl. No.	:	10/747,840
Confirmation No.	:	6450
Applicant	:	William T. Graushar, et al.
Filed	:	December 29, 2003
Title	:	METHOD AND APPARATUS FOR ASSEMBLING PERSONALIZED ELECTRONIC MEDIA INTO PRINTED PRODUCTS
TC/A.U.	:	3651
Examiner	:	Patrick Hewey Mackey
Docket No.	:	077047-9410-02
Customer No.		23409

I, Susan L. Buckingham, hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date of my signature.

Susan L. Buckingham
Signature

May 2, 2006
Date of Signature

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REPLY BRIEF

Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed March 10, 2006, and is filed within the two-month period for response. Charge or credit Deposit Account No. 13-3080 with any shortage or overpayment of the fees associated with this Reply Brief.

This Reply Brief only addresses some of the arguments presented by the Examiner and is submitted as a supplement to the arguments already presented in the Appeal Brief filed December 21, 2005.

Claim 1

Independent claim 1 defines a method comprising the acts of writing electronic information to an optical disk on a binding line and associating the written optical disk with a printed product on the binding line.

When addressing the §102 rejection of claim 1 by Hill '815, the Examiner argues that limiting claim 1 to CDs and DVDs would render claim 1 indefinite because claim 2 recites CDs,

CD-ROMs, and DVDs. From this, the Examiner concludes that because claim 1 must be broader than claim 2, the term "optical disk" in claim 1 must "encompass other storage mediums", in other words, claim 1 must encompass magnetic media such as a magnetic strip.

Initially, Applicants respectfully submit that Applicants did not argue that the optical disk of claim 1 be limited to CDs and DVDs, but instead merely cited to the specification to provide the Examiner with examples of optical disks by using the phrase "such as CDs and DVDs." Applicants submit that the optical disk in claim 1 is broader than merely CDs and DVDs.

In addition, although Applicants agree that claim 1 must be broader than claim 2, Applicants strongly disagree with the Examiner's assertion that this requires that the term "optical disk" be construed to also include storage mediums other than those categorized as optical disks to encompass, for example, magnetic strips. The Authoritative Dictionary of IEEE Standards and Terms (Seventh Edition) defines an optical disk as "[a] disk on which information is stored and retrieved by optical means, using a laser." This definition is clearly broader than only CDs, CD-ROMs, and DVDs, and could also include laser disks, digital optical disks, and numeric optical disks.

Furthermore, Applicants submit that one of ordinary skill in the art would recognize that the term "optical disk" excludes magnetic media such as a magnetic strip. The definition provided above clearly excludes magnetic strips that are not disks and store and retrieve information by magnetic means as opposed to optical means. Therefore, in no way can the magnetic strip disclosed in Hill'815 be considered to be an optical disk.

For at least the reasons noted above, Hill '815 does not teach or suggest the subject matter of claim 1.

When addressing the §103 rejection of claim 1 by Pace and Hill '815, the Examiner provides the unsupported, conclusory statement that "[i]t would have been obvious for a person of ordinary skill in the art at the time of the appellant's invention to modify Pace by writing electronic information to the optical disk on the binding line for the purpose of delivering owner specific electronic media to an account owner." The Examiner cites col. 7, lines 4-20 of Hill '815 as support for this motivation, however a review of the cited passage reveals that this passage instead only relates to a verification process that ensures only correctly embossed and encoded cards are attached to matching carrier forms. Pace does not require verification, nor does anything in the Pace reference suggest the desirability of implementing a verification

process where information is written to the disk on the binding line and then verified for accuracy. There is simply no suggestion to modify Pace as suggested by the Examiner except in Applicants' own disclosure.

Further, the Pace system as taught in the Pace reference would be unable to write information to a disk on the binding line, but rather is designed to package pre-written CDs. To configure the Pace system to be able to write information onto the disks on the binding line, as recited in claim 1, would require a complete redesign of the Pace system, which is simply not taught by either Pace or Hill '815.

For at least these reasons, the combination of Pace and Hill '815 does not teach or suggest the subject matter defined by claim 1.

Accordingly, Applicants submit that independent claim 1 is allowable.

Claim 6

Independent claim 6 defines a method including the acts of reading electronic information from an optical disk on a binding line, and associating the optical disk with a printed product on the binding line.

When addressing the §102 rejection of claim 6 by Hill '815, the Examiner states that the magnetic strip disclosed by Hill '815 teaches the optical disk feature of claim 6 for the same reasons as provided in support of his rejection of claim 1. The arguments presented above with respect to claim 1 apply with equal weight to claim 6.

When addressing the §103 rejection of claim 6 by Pace and Hill '815, the Examiner provides the unsupported, conclusory statement that "[i]t would have been obvious for a person of ordinary skill in the art at the time of the appellant's invention to modify Pace by reading electronic information from the optical disk on the binding line for the purpose of delivering owner specific electronic media to an account owner." The Examiner cites col. 7, lines 4-20 of Hill '815 as support for this motivation, however a review of the cited passage reveals that this passage instead only relates to a verification process that ensures only correctly embossed and encoded cards are attached to matching carrier forms. Pace does not require verification, nor does anything in the Pace reference suggest the desirability of implementing a verification process where information is read from the disk on the binding line and then verified for accuracy. In fact, once the CD is packaged within the folder, information cannot be read from

the CD any longer. There is no suggestion within the references as to why a modification to the Pace system would be necessary to allow for reading of the information on the CD for verification and/or printing purposes as the Pace system is designed for use with preprinted CDs containing only generic information that need not be verified. There is simply no motivation to combine the references, as suggested by the Examiner, outside of Applicants' own disclosure.

For at least these reasons, the combination of Pace and Hill '815 does not teach or suggest the subject matter of claim 6.

Accordingly, independent claim 6 is allowable.

Claim 11

Independent claim 11 defines a method comprising the acts of reading electronic information from an optical disk on a binding line, wherein the optical disk has been electronically written offline with respect to the binding line, and associating the optical disk with a printed product on the binding line.

When addressing the §102 rejection of claim 11 by Hill '453, the Examiner states that the IC chip 32 and the bar code 44, 46 teach the optical disk feature of claim 11 because they are optically read.

In response, Applicants again assert that Hill '453 does not teach or suggest reading electronic information from an optical disk on a binding line. The system of Hill '453 is not designed for use with, nor does Hill '453 teach using, an optical disk as specified in independent claim 11. Hill '453 discloses an IC chip reader 64 to read the IC chip 32 and bar code readers 68, 70 to read the bar codes 44, 46. Simply, an IC chip or a bar code is not an optical disk. Regardless of whether optical means is used on the storage device to store or retrieve information, the IC chip or bar code clearly does not satisfy the first criteria of the above definition of optical disk, which requires it to be "a disk". Therefore, Hill '453 does not use or teach the use of an optical disk.

For at least these reasons, Hill '453 does not teach or suggest the subject matter defined by claim 11.

Accordingly, independent claim 11 is allowable.

Claim 21

Independent claim 21 defines a method comprising the acts of writing electronic information to an optical disk on a binding line, delivering a plurality of printed products to the binding line based upon the information written to the optical disk, and associating the printed products and the optical disk on the binding line.

When addressing the §102 rejection of claim 21 by Hill '815 and the §103 rejection of claim 21 by Pace and Hill '815, the Examiner states that Hill '815 discloses delivering a plurality of printed products to a binding line based upon information written to an optical disk. In support of this statement, the Examiner explains that Hill '815 discloses "a relationship between the information written to the [magnetic strip] and information printed on the product." As the information written to the magnetic strip changes, "different products with different information are delivered to be bound."

Applicants concede that a relationship exists between the information written to the magnetic strip and information printed on the product, however Applicants strongly submit that this relationship is very different from the claimed relationship. The claimed relationship requires that the plurality of printed products are delivered to the binding line based upon information written (*past tense*) to the optical disk. There is an important timing element to the claimed relationship that is not taught in Hill '815. The claim language requires that printed products are delivered to the binding line after the information has been written to the optical disk. In the case of Hill '815, the information is written to the magnetic strip only *after* the printed product has already been delivered to the binding line. Therefore, Hill '815 could not possibly teach the claim feature requiring that the printed products be delivered to the binding line based on information that has already been written to the storage device.

For at least these reasons, Hill '815 does not teach or suggest the subject matter of claim 21, and the combination of Pace and Hill '815 does not teach or suggest the subject matter of claim 21.

Accordingly, independent claim 21 is allowable.

Claim 22

Independent claim 22 defines a method comprising the acts of writing electronic information to an optical disk on a binding line, delivering a plurality of printed products to the

binding line based upon the information read from the optical disk, and associating the printed products and the optical disk on the binding line.

When addressing the §102 rejection of claim 22 by Hill '815 and the §103 rejection of claim 22 by Pace and Hill '815, the Examiner states that Hill '815 discloses delivering a plurality of printed products to a binding line based upon information read from an optical disk. In support of this statement, the Examiner explains that Hill '815 discloses reading information from a magnetic strip, and if the information from the printed products does not match the information from the magnetic strip, then magnetic strip is not bound with the printed products.

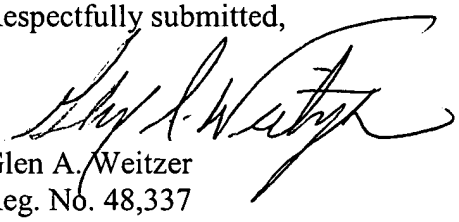
Applicants concede that a relationship exists between the information read from the magnetic strip and information printed on the product, however Applicants strongly submit that this relationship is very different from the claimed relationship. The claimed relationship requires that the plurality of printed products are delivered to the binding line based upon information read (*past tense*) from the optical disk. There is an important timing element to the claimed relationship that is not taught in Hill '815. The claim language requires that printed products are delivered to the binding line after the information has been read from the optical disk. In the case of Hill '815, the information is read from the magnetic strip in a verification process only *after* the printed product has already been delivered to the binding line. Therefore, Hill '815 could not possibly teach the claim feature requiring that the printed products be delivered to the binding line based on information that has already been read from the storage device.

For at least these reasons, Hill '815 does not teach or suggest the subject matter of claim 22, and the combination of Pace and Hill '815 does not teach or suggest the subject matter of claim 22.

Accordingly, independent claim 22 is allowable.

In view of the foregoing, reversal of the final rejection of claims 1-4, 6-9, 11-14, 21, and 22 and allowance of claims 1-4, 6-9, 11-14, 21, and 22 are respectfully requested.

Respectfully submitted,



Glen A. Weitzer
Reg. No. 48,337

Docket No. 077047-9410-02
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Suite 3300
Milwaukee, Wisconsin 53202-4108
414.271.6560

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